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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,550	11/30/1999	ROBERT G. NADON	M-7739-US	7807

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EXAMINER	
WOOD, WILLIAM H	

ART UNIT	PAPER NUMBER
2124	15

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/450,550	NADON ET AL.	
	Examiner	Art Unit	
	William H. Wood	2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,17 and 33-42* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,17 and 33-42* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1, 17 and 33-42 remain pending and have been examined.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 October 2003 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 17 and 33-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claims contain limitation "translates *contemporaneously* with the installation", which is not supported in the original disclosure. The original disclosure does make mention of "substantially contemporaneously" on page 14, line 5 of the original specification (the two meanings are different). The new matter is required to be removed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 17 and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (USPN 6,247,128) in view of Lowry (USPN 5,946,002) in view of "Dictionary of Computing: Fourth Edition" herein referred to as Computing in view of Garcia et al. (USPN 5,359,725) and in further view of Barsness et al. (USPN 5,960,206).

In regard to claim 1, Fisher disclosed the limitations:

- *A method of installing desired-language translations of software in a computer system, the software to be installed, at the time of assembly of the computer system, in response to a customer's order* (column 1, lines 14-19; column 11, lines 7-12), *the method comprising:*
  - *creating a record that comprises identifiers that specify software to be installed in the computer system* (column 11, lines 7-12 necessitates a record of the build information);

- *reading, from the record, a first identifier that identifies operating system software to be installed in the computer system* (column 27, lines 22-33; Fisher has a list of components to be installed (including the operating system) and therefore is reading from the list);
- *based on the first identifier, establishing a first variable that specifies the operating system type* (column 27, lines 22-33; shows selectable operating system) *and a second variable that specifies a desired language* (column 27, lines 22-33; shows selectable language);
- *reading, from the record, a second identifier that identifies other software to be installed in the computer system* (column 27, lines 40-48; list of software components);
- *parsing the second identifier into a call to a batch file that (i) causes a native language version of the other software to be installed in the computer system* (column 11, lines 39-44; column 27, lines 30-33; set-up routines allows for the initial installation of a native-language if that is all that is available based upon what software is selected)

Fisher did not explicitly state a second entity to translate text portions of software to a desired language. Lowry demonstrated that it was known at the time of invention to translate text portions of software (column 1, line 65 to column 2, line 24). It would have been obvious to one of ordinary skill in the art at the time of invention to implement Fisher's software installation system with the ability to translate software text to a desired language as found in Lowry's teaching. This implementation would have been

obvious because one of ordinary skill in the art would be motivated to provide a system complete to a user's specification. Furthermore, Fisher indicates it is desirable to provide software in a desired language (column 27, lines 30-33). Finally, multiple translation routines are present in that one would want to translate for multiple languages.

Neither Fisher nor Lowry explicitly stated using scripts for installation and translation. However, Computing demonstrated that it was known at the time of invention to use scripts to perform often-used functions, commands or actions (page 434). It would have been obvious to one of ordinary skill in the art at the time of invention to implement Fisher and Lowry's system of installing desirable language translated software with utilizing scripts for the purpose as found in Computing's teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to use a well understood and common procedure for implementing actions. Specifically, Fisher indicates utilizing set-up routines for installing software (column 11, lines 39-44), and thus the script is identified by the software. This action obviously would be implemented by the installation scripting system, along with downloading the software.

Fisher, Lowry and Computing did not explicitly state the limitation *based on the type of file in which the other software is stored, and based on the operating system software, the translation script selects a translation routine from a set of available translation routines.* Lowry demonstrated that it was known to one of ordinary skill in the art at the

time of invention to localize or translate files of multiple differing types (column 2, lines 2-14 and column 2, line 64 to column 3, line 7; the mention of these external resource files containing different information indicates at least two types of files). It would have been obvious to one of ordinary skill in the art at the time of invention to implement Fisher, Lowry and Computing's installation and translation with selecting a translation routine based on file type as suggested by Lowry's own teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to provide the most accurate translation possible by tailoring localization and translation to the type of file, which contains the data to be translated. Additionally, Garcia demonstrated at the time of invention that multiple differing operating systems employ differences in files and storage as well (column 1, lines 23-32). In view of operating system propriety and differencing, it would have been obvious to one of ordinary skill in the art at the time of invention to implement Fisher, Lowry and Computing's installation and translation not only selecting based upon file type but also with selecting a translation routine based upon operating system software present as suggested through the teachings of Garcia. This implementation would have been obvious because one of ordinary skill in the art would be motivated to provide the most accurate translation possible by tailoring localization and translation to the operating system software present.

Fisher and Lowry did not explicitly state substituting translations "contemporaneously" with installation of other software. Barsness demonstrated that it was known at the time

of invention to install components of software simultaneously (column 2, lines 4-7; column 7, lines 51-55). It would have been obvious to one of ordinary skill in the art at the time of invention to implement the installation system of Fisher, Lowry, Computing and Garcia with installing translated components along with other software components simultaneously or contemporaneously as found in Barsness' teaching. This implementation would have been obvious because one of ordinary skill in the art would be motivated to make total installations quickly and produce a finished product quickly (Barsness: column 7, lines 51-55).

In regard to claim 33, Fisher, Lowry, Computing and Garcia further disclosed the limitation *providing a server for storing the native-language version of the software* (Fisher: Figure 1; column 4, lines 55-62).

In regard to claim 34, Fisher, Lowry, Computing and Garcia further disclosed the limitation *coupling the computer system to the server during installation of the software* (Fisher: Figure 1; column 4, lines 55-62).

In regard to claim 35, Fisher, Lowry, Computing and Garcia further disclosed the limitation *wherein the record is accessible to the server* (Fisher: Figure 1; column 4, lines 55-62).

In regard to claim 36, Fisher, Lowry, Computing and Garcia further disclosed the limitation *an installation script stored on the server* (Fisher: Figure 1; column 4, lines 55-62)

In regard to claim 37 Fisher, Lowry, Computing and Garcia further disclosed the limitation *wherein the translation script is stored on the server and is called by the installation script which, in turn, calls the translation routine* (Figure 1; column 4, lines 55-62 in view of the above obvious combinations).

In regard to claims 17 and 38-42, the method of claim 17 correlates to the method of claim 1 and as such the limitations of claim 17 are rejected in the same manner as for claim 1. Claims 38-42 correspond to claims 33-37 and are rejected similarly.

6. Claims 1, 17 and 33-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fisher et al. (USPN 6,247,128) in view of Lowry (USPN 5,946,002) in view of "Dictionary of Computing: Fourth Edition" herein referred to as Computing and in further view of Garcia et al. (USPN 5,359,725). The rejection of Office Action mailed 16 July 2003 still stands with additional note below.

Fisher and Lowry did not explicitly state substituting translations "contemporaneously" or "substantially contemporaneously" with installation of other software. Official Notice is taken that it was known at the time of invention to install components of software

simultaneously or nearly simultaneously. It would have been obvious to one of ordinary skill in the art at the time of invention to implement the installation system of Fisher, Lowry, Computing and Garcia with installing translated components along with other software components nearly simultaneously or contemporaneously (installing and immediately translating or translating and then installing, ie. "substantially contemporaneously"). This implementation would have been obvious because one of ordinary skill in the art would be motivated to make total installations/configurations quickly and thus produce a finished product quickly.

Response to Arguments

7. Applicant's arguments filed 14 October 2003 have been fully considered but they are not persuasive. Applicant argued [i)] the cited prior art does not disclose substitution of translation contemporaneously with installation of other software and [ii)] there is no motivation for the prior art's combination. Neither of these statements is correct. The first point is addressed in the above rejections. As to the second point proper combinations and motivations were provided as described above in the rejections. Applicant has offered nothing other than a broad assertion that such combinations are improper. Thus, the rejections are maintained as there is no reasoning not to maintain them in light of their proper standing. Finally, Applicant is reminded:

> In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Therefore, having addressed Applicant's concerns, the rejections are maintained as above stated.

Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. Wood whose telephone number is (703)305-3305. The examiner can normally be reached 7:30am - 5:00pm Monday thru Thursday and 7:30am - 4:00pm every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (703)305-9662. The fax phone numbers for the organization where this application or proceeding is assigned are (703)746-7239 for regular communications and (703)746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

William H. Wood
December 19, 2003

KAKALI CHAKI
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